

Application Number 10/813,307
Response to Office Action mailed September 4, 2007

REMARKS

Claims 1-5, 17-32, 41-47, and 67-68 are pending in the application.

In this response, claims 1 and 29 are amended as suggested by the Examiner to structurally distinguish the devices in the cited references.

Claims 6-16, 33-40 and 48-66 are cancelled without prejudice or disclaimer, and Applicants reserve the right to file at a later date divisional applications directed to the subject matter of these claims.

In view of the above amendments and the following remarks, Applicants respectfully request further examination of the application and reconsideration of the rejections set forth in the Office Action dated September 4, 2007.

Claim Rejection Under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 1-3, 24-27, 29-31, 45-46 under 35 U.S.C. 102(c) as being anticipated by Kilcoyne et al. (US 6,689,056). The Examiner also rejected claims 1-3, 24-31, 45-47 under 35 U.S.C. 102(e) as being anticipated by Colliou et al. (US 7,020,531). Applicant respectfully traverses the rejection to the extent such rejection may be considered applicable to the amended claims. Kilcoyne and Colliou fail to disclose each and every feature of the presently claimed invention and provide no teaching that would have suggested the desirability of modification to include such features.

Independent claim 1 as amended requires a controlled detachment mechanism mechanically actuated to selectively self-detach the device housing from the surface of the body lumen. Independent claim 29 also requires similar elements. Support for the amendment of "self-detach" in claims 1 and 29 can be found throughout the Specification. Specifically, the Specification states that "[a] detachment mechanism is configured to permit medical device 20 to self-detach from the target location, i.e., without the need for endoscopic intervention."¹ No new matter is being entered into the record by way of this amendment.

Kilcoyne requires either dissolvable materials² or deployment catheter 138 via the working channel of an endoscope³ to detach monitor 18 from esophagus 30. The Kilcoyne.

¹ Specification, Paragraph [0050].

² Kilcoyne et al., Col. 9-10, ll. 66-2.

³ *Id.*, Col. 13, ll. 14-23.

Application Number 10/813,307
Response to Office Action mailed September 4, 2007

monitor 18 requires an additional deployment catheter 138 to enter the patient in order to detach monitor 18 through mechanical actuation. In contrast, the claimed invention is a medical device that includes a controlled detachment mechanism mechanically actuated to selectively self-detach the device housing from the surface of the body lumen. Kilcoyne's monitor 18 cannot self-detach through mechanical actuation. Therefore, Kilcoyne fails to teach or suggest the elements of amended claims 1 and 29.

The Colliou system requires grasping instrument 556 and grasping jaws 557 to "advance or retract the needle 524"⁴ that attaches or detaches device 20 from the stomach wall. In this manner, "grasping instrument 556 grasping instrument 556 with grasping jaws 557 at its distal end extends through the endoscope 110."⁵ The Colliou device 20 requires an additional endoscope 110 to enter the patient, retract needle 524, and detach device 20. As with Kilcoyne above, the Colliou device 20 cannot self-detach through mechanical actuation. Therefore, Colliou fails to teach or suggest the elements of amended claims 1 and 29.

Dependent claims 2-3, 17-19, 24-31, and 45-47 are dependent upon independent claims 1 and 29 and allowable for at least the reasons set forth with respect to claims 1 and 29.

The disclosures of Kilcoyne and Colliou both fail to disclose each and every limitation set forth in claims 1-3, 17-19, 24-31, and 45-47. For at least these reasons, the Examiner has failed to establish anticipation of Applicant's amended claims 1-3, 17-19, 24-31, and 45-47 under 35 U.S.C. 102(e). Withdrawal of this rejection is requested.

Rejection for Obviousness-type Double Patenting:

The Examiner rejected claims 1-3, 16, 18-19, 24-27, 29-31, 45-46 on the ground of nonstatutory obviousness-type double patenting over claims 1-26 of U.S. Patent No. 6,689,056.

The Examiner provisionally rejected claims 1, 18, 24-27, 29, 45-46 on the ground of nonstatutory obviousness-type double patenting over claims 15-17, 62-87 of copending Application No. 10/833,776.

⁴ Colliou et al., Col. 12, ll. 1-2.

⁵ *Id.*, Col. 13, ll. 1-3.

Application Number 10/813,307
Response to Office Action mailed September 4, 2007

The Examiner provisionally rejected claims 1-3, 18, 24-27, 29-31, 45-46 on the ground of nonstatutory obviousness-type double patenting over claims 10-11, 13-16, 55-58, 61-66 of copending Application No. 10/687,296.

The Examiner provisionally rejected claims 1-3, 16, 18, 19, 24-27, 29-31, 45-46 on the ground of nonstatutory obviousness-type double patenting over claims 55-58, 66, 69, 71, 73 of copending Application No. 10/896,533.

The Examiner provisionally rejected claims 1-3, 18, 24-31, 45, 46 on the ground of nonstatutory obviousness-type double patenting over claims 1-53 of copending Application No. 10/835,425.

A. U.S. Patent No. 6,689,056

For the following reasons, Applicants respectfully traverse the double patenting rejection over claims 1-26 of U.S. Patent No. 6,689,056.

Independent claims 1 and 29 as amended require a controlled detachment mechanism mechanically actuated to selectively self-detach the device housing from the surface of the body lumen. In contrast, the claims of Kilcoyne require either dissolvable materials⁶ or use of a deployment catheter 138 via the working channel of an endoscope⁷ to detach monitor 18 from esophagus 30. The Kilcoyne monitor 18 requires an additional deployment catheter 138 to enter the patient in order to detach monitor 18 through mechanical actuation. In contrast, the claimed invention is a medical device that includes a controlled detachment mechanism mechanically actuated to selectively self-detach the device housing from the surface of the body lumen. Kilcoyne's monitor 18 cannot self-detach through mechanical actuation.

For the above reasons, Kilcoyne fails to teach or suggest the elements of amended claims 1 and 29, and reconsideration and withdrawal of the double patenting rejection are respectfully requested.

⁶ Kilcoyne et al., claims 5, 9, 24.

⁷ This approach to device removal is not addressed in the claims of the Kilcoyne patent.

Application Number 10/813,307
Response to Office Action mailed September 4, 2007

B. Provisional Double Patenting Rejections

Applicants note the provisional nature of the remaining double patenting rejections, and these rejections will be addressed when and if they are formally applied.

Allowable Subject Matter

In the Office Action, the Examiner indicated that claims 67 and 68 are allowed. Additionally, the Examiner indicated that claims 4-5, 20-23, 32 and 41-44 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant appreciates the allowance of claims 4-5, 20-23, 32 and 41-44 if written in independent form. Applicant has not incorporated elements from claims 4-5, 20-23, 32 and 41-44 into their respective independent claims; however, Applicant reserves the right to rewrite claims 4-5, 20-23, 32 and 41-44 in their independent form at a later time.

CONCLUSION

All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims.


Please charge any additional fees or credit any overpayment to deposit account number 50-1778.

If questions remain regarding the above, please contact the undersigned.

Date:

By:

January 4, 2008
SHUMAKER & SIEFFERT, P.A.
1625 Radio Drive, Suite 300
Woodbury, Minnesota 55125
Telephone: 651.735.1100
Facsimile: 651.735.1102


Name: H. Sanders Gwin, Jr.
Reg. No.: 33,242